UNITED STATES PATENT AND TRADEMARK OFFICE

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			EXAMINER
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ART UNIT	PAPER NUMBER
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NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *14 March 2008*.

2a) ☒ This action is **FINAL**.　　　　2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1,3,4,6-9,12,15,16,18 and 20* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1, 3, 4, 6-9, 12, 15, 16, 18 and 20* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a) ☐ All　b) ☐ Some * c) ☐ None of:

　　　1. ☐ Certified copies of the priority documents have been received.

　　　2. ☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: application, filed 8/18/2003;

amendment filed 3/14/2008.

2.   Claims 2, 5, 10, 11, 13, 14, 17 and 19 have been cancelled by the applicant.

Response to Arguments

3.   Applicant argues: "The Office Action pointed specifically to step 54 of Richman,

which relates to the inquiry to identify the subset of devices that must be active upon completion

of a boot process. Identifying devices for completion of a boot process, as taught by Richman, is

completely unrelated to the claimed subject matter, which recites executing first code (to prompt

for entry of the key at a later time) during a boot procedure of the system, and during execution

of such first code, providing another prompt for entry of a second key." However, said portion

of Richman was cited to show the limitation of executing a code during the boot

procedure. As admitted by the applicant, the cited portion shows an inquiry to identify

the subset of devices that must be active upon completion of a boot process. Therefore,

it teaches the cited requirement. It is also noted that the subject matter of Richman is

related to booth procedures, and ensuring that the system is ready and prepared before

the boot process id finished. Applicant's invention is also directed to the same subject

matter. Therefore, the subject matter of Richman and the claimed invention are not

unrelated.

Applicant further argues: "Dolphin does not disclose installing software in the system and storing an entered key **"in response to determining that the entered key is proper,"** as recited in claim 1. In Dolphin, the key is downloaded and stored **in response to a user request** for a particular key and then used or entered to access data. As such, an **entered** key is not stored **in response to determining that the entered key is proper**, as recited in claim 1. In other words, in Dolphin, a user requests a key from the billing/access center, and the key is downloaded in response to such request. There is no further verification of the key to determine that the key is proper, followed by further storing of the previously entered key in response to such verification." Dolphin does download and store a key in response to a user request for a key. However, there are additional cited features of Dolphin that teach storing the key in response to determining that the key is proper. Note that Dolphin teaches subsequent use of the key after the key is used for the first time (as an example, see col. 6 lines 54-65). After the key is downloaded to the user's PCMCIA, it will be used for the subsequent access to information. Therefore, when the key is verified and determined proper, it will be stored in the user PCMCIA for the subsequent use. Dolphin also teaches an updating process (zeroization, as shown in col. 7 lines 20-28). In the zeroization process, the number of usage or the length of time of usage is recorded and audited using the PCMCIA. When the number of use or length of time expires, the key is zeroized (see also col. 7 line 28 to col. 8 line 24). Therefore, the key must be stored in PCMCIA after it is verified and determined that it is <u>not</u> expired, so that it can be used for subsequent access. More details on Dolphin's updating process can be found in col.

10 line 7 to col. 13 line 48. Specifically, col. 3 lines 34 to 48 shows that the current key is used in the updating process, and the updated key is used for access to next publication. Therefore, the current key is clearly stored after it is verified.

Dolphin also teaches an updating process to allow access within a time limit, or control access to limited versions of data. The example in col. 12 lines 28 to col. 13 line 34 shows Dolphin teaching access to data (subscription) within a period of six months, and no access thereafter, unless a new key is purchased. Therefore, when the user enters a key to access the data after the sixth month, the keys are deemed improper for accessing the latest version (seventh month), but the data for the sixth month is still accessible. Therefore, while the key is improper for accessing the seventh month publication, the sixth month publication is accessible and can be downloaded. Another example is shown in col. 5 line 40 to col. 6 line 10, where Dolphin teaches partial or "trial period" access. The user enters the code for partial access and will not be allowed full access (for example, cannot print or copy), but still has access to the file for viewing. As mentioned before, Dolphin teaches software as one type of data that can be stored and accessed. Therefore, Dolphin teaches accessing the older version of a software, while requiring a new key when the new version is made available. Therefore, the key is improper for the new version, but the old version is available.

More importantly, It is noted that claim 1 installs the software regardless of whether the proper code is entered or not. In other words, entering the proper or not proper key is

irrelevant to whether the software is installed, as the software is installed either way. Therefore, the claim can be interpreted as installing the software, and storing the key when it is proper, and initiate a program to ask the user to enter the key, when the key is not proper. It is further noted that applicant's disclosure includes installing a disabling code when the proper key is not entered. Presence of the disabling code allows control of access to the software. Without the disabling code, there is no control over accessing the software, as the unauthorized user (the one without the proper key) will have full access to the software, and the key is immaterial in access control. Note that the utility established for the claimed invention is in software installation with access control. Without access control, a critical element of invention is missing.

Lastly, Applicant argues: "Moreover, it is respectfully submitted that a person of ordinary skill in the art would not have been prompted to combine the teachings of Dolphin and Richman. As discussed above, Dolphin relates to downloading a key to a PCMCIA card for the purpose of accessing content of a CD. On the other hand, Richman refers to configuring devices during a boot procedure. Such teaching of Richman is completely unrelated to the teachings of Dolphin. The Office Action has failed to provide any explanation of why configuration of devices such as network adapters, as taught by Richman, would have any relevance in the context of Dolphin, which relates to downloading a key from a billing/access center to a PCMCIA card, and using that key to access content of a CD." However, as indicated in the rejection, Dolphin and Richman are analogous art, as they are both directed to installing data and software in computer and information systems. The rejection also includes a motivation for

combining Dolphin and Richman. Applicant's argument does not discuss the cited

reason for combination, and therefore, is found non persuasive.

Applicant's argument relative to claims 9 and 16, and all the dependent claims is based

on the same argument as claim 1. Therefore, applicant's argument relative to all claims

is found non persuasive and the rejection is maintained.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1, 3, 4, 6-9, 12, 15, 16, 18 and 20 rejected under 35 U.S.C. 103(a) as

being unpatentable over Dolphin (US Patent No. 5,457,746, dated Oct. 10, 1995), and

further in view of Richman (U.S. Patent No. 6,003,097, dated Apr. 9, 1997).

5.1.   As per claim 1, Dolphin is directed to a method of installing software in a system,

comprising: during an installation procedure, providing a user prompt to request entry of

a key (col. 4 lines 39-48. Also note col. 5 line17-20, where "software" is clearly indicated

as one of data that may be stored on a CD, and made available to user for installation);

determining whether an entered key is proper; in response to determining that the

entered key is proper, installing the software in the system and storing the entered key

(col. 6 lines 54 to 58 shows access to data (software installation when the stored data is

a software) and storing of the key when the key is proper); in response to determining

that the entered key is not proper, installing the software in the system and enabling

activation of first code to prompt for entry of the key at a later time (the scenario when

the proper key is not entered is taught by Dolphin when a key is expired. According to

col. 6 line 58 to col. 7 line 28, when the key is expired (not proper) the program requires

entry of a new key. Therefore when the software was installed, the program to prompt

for entering a key at a later time, must have been initiated); after enabling activation of

the first code, executing the first code during a boot procedure of the system (Dolphin

does not show execution of a code during a boot procedure of the system. Richman

shows execution of codes during boot procedure. These codes are determined to be

necessary to execute during the boot procedure (see step 54 of Fig. 4A and associated

text) Dolphin and Richman are analogous art, as they are both directed to installing data

and software in computer and information systems. At the time of invention, it would

have been obvious to the one skilled in art to perform the code execution to verify keys

as taught by Dolphin, during the boot procedures, as taught by Richman. The motivation

to do so would have been to limit system access at the boot level only to the ones with

authority (holding a proper key)); during execution of the first code, providing another

prompt for entry of a second key (Dolphin shows that a new key (second key) is

required after the first key is expired).

5.2.   As per claim 3, Dolphin is directed to he method of claim 1, further comprising:

determining, by the first code, whether the second key is proper; and not executing the

installed software in response to the second key not being proper (See response to

claim 2, and note that the purpose of verification of a key is to allow or disallow access

and the standard response to entering an improper key is access denial).

5.3.   As per claim 4, Dolphin is directed to the method of claim 3, further comprising

storing the second key in a registry in response to the second key being proper (the

new key (second key) must be stored in the registry so it could be checked if it is

proper).

5.4.   As per claim 6, Dolphin is directed to the method of claim 4, further comprising:

during execution of the installed software, providing a prompt for entry of a third key

(Dolphin and Richman teach verification of multiple keys (first and second keys) to

determine if a software should be installed or not. Verification of a third key would have

been obvious to the one skilled in art).

5.5.   As per claim 7, Dolphin is directed to the method of claim 6, further comprising:

determining whether the third key is proper; and stopping execution of the installed

software in response to determining that the third key is not proper (per col. 6 line 58 to

col. 7 line 28, Dolphin's system check for validity of the key, and if the key is expired,

requires a new key. It is the standard procedure that if an access code is not valid, the

access is denied, which in this case means termination of the software execution. See

also response to claim 6).

5.6.   As per claim 8, Dolphin is directed to the method of claim 1, further comprising:

during execution of the installed software, providing a prompt for entry of a third key;

determining whether the third key is proper; and stopping execution of the installed

software in response to determining that the second key is not proper (see response to

claims 1 and 7).

5.7.   The limitations of claims 9, 12, 15, 16, 18 and 20are substantially the same as

imitations of claims 1, 3, 4, 6-8 above.

Conclusion

6.   **THIS ACTION IS MADE FINAL,** as no new ground of rejection is included. See

MPEP § 7.39. Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Farid Homayounmehr whose telephone number is (571)

272-3739. The examiner can be normally reached on 9 hrs Mon-Fri, off Monday

biweekly.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kristine Kincaid can be reached on (571) 272-4063. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Farid Homayounmehr

7/5/2008

/Kristine Kincaid/

Supervisory Patent Examiner, Art Unit 2139